

## REMARKS

The helpful and courteous interview granted the undersigned attorney on April 21, 2005 is gratefully acknowledged. The Examiner has withdrawn his indicated allowability of claims 15, 16, 35, 36, 41-48 and 52-55 based on a newly discovered reference to Compton.

The Examiner asserts he has made a prima facie showing of obviousness based on Kunz, U.S. Patent 6,295,776 in view of Compton, U.S. Patent No. 2,853,871 and Weldy, Re 34, 547.

As discussed during the foregoing interview, Kunz actually teaches away from Applicant's invention. This is born out by his subsequent filing of a CIP application demonstrating he would have provided a drywall trim of Applicant's construction had he conceived of it previously.

As conceded by the Examiner, Kunz does not show a flap having an elongated grooves and ridges on the inner surfaces for anchoring in the joint compound on the drywall corner joint. Rather, Kunz relied on abrasion to facilitate adhesion and did not turn to bodily deforming the paper to achieve Applicant's results until the filing of the application for his U.S. Patent No. 6,539,680. Kunz incorporates a small diameter holes in his flat, planar paper wing suggesting that the cement 28 be "applied to the exterior surface thereof" (Col. 4, ll. 54-55) and fails to mention any effort to physically deform the bodies of wings on the inner surfaces to provide inwardly projecting ridges to anchor into drywall joint compound. As the Examiner conceded during the interview, to carry the case in showing prima facie obviousness, the burden is on the U.S.P.T.O. to demonstrate bodily deformation of wings to provide inward projections for anchoring into drywall cement. The burden is further on the Examiner to demonstrate that it would have been obvious to modify Kunz to incorporate such a modification.

In this regard, Compton is directed to a metallic expansion joint for use with heat insulation covers such as that surrounding hot water tanks or steam pipes where wide ranges of temperature may be encountered. Compton was seeking to accommodate expansion and contraction due to temperature changes and "resisting shifting" of the insulated slabs (Col. 1, line 28). He states that his objective is to "provide a metal joint structure that will not only maintain the blocks in approximately their original relative positions, but will more effectively seal the joints and prevent formings of cracks or fissures that would allow escape of heat" (Col. 2, ll. 6-10).

Compton forms his expansion joint with a hollow tubular metal bead 17 having a central bore for receipt of alignment pins 18 (Figs. 5 and 8) to maintain abutting expansion strips in alignment. He then forms the metal on the opposite sides of the beads with a single fold or bend 19 and turns the metal outwardly to form "wing-like extensions 20 that are of foraminous or mesh form." As pointed out in the interview, he states that these extensions may be simply extensions of the body of the strip "slitted and stretched and expanded metal or may have numerous holes punched therethrough, or be of other mesh-like material welded to the edges of the body portion of the strip" (Col. 2, ll. 22-25). He then provides a corrugated strip of springing sheet metal which has an upper approximately-straight flange 23 and is welded or simply extends into the strips, between the bends 19. Staples 24 are driven through the wings, probably through the holes in the mesh (Figs. 1 and 8).

The Examiner argues that Compton shows flaps 20 having elongated grooves and ridges with at least the inward surface including ridges for anchoring the joint compound 21, at least the outward surfaces including grooves. It is possible the Examiner misconstrued the description in the Compton patent. That is, while Figure 1 shows undulating lines in the extensions 20, those undulating lines are no where described as being grooves and ridges and but, rather, are described as foraminous or mesh form. The Examiner fails to provide any definition for foraminous or mesh. Mesh is described in Webster's 7<sup>th</sup> New Collegiate Dictionary as one of the openings between the threads or

cords of a net or one of the similar spaces in a network. Mesh is not thought of as being formed with ridges and grooves and, nowhere does Compton suggest any utility for ridges and grooves in his extensions. The Examiner states without evidentiary support that it would have been obvious to modify Kunz to show the flap having an elongated grooves and ridges on at least the inward surface for anchoring the joint compound on the drywall corner as taught by Compton. The Examiner cites no basis for this contention and fails to recognize that incorporation of metal mesh wings in Kunz would defeat his objective of Kunz to employing smooth paper stock like "GSM Sand Back" (Col. 4, ll. 29-30). Mesh would make a rough unsatisfactory flap. One working in the art would be dissuaded from covering the metal core with a metal cover and flap in effort to obtain the benefits provided by Applicant's invention.

In any event, there is no teaching in the art what configuration, size or dimension grooves and ridges should take in order to provide the function of anchoring into the underlying drywall compound as taught by Applicant.

The Examiner fails to recognize that Compton is focused on insulative plastic material and is not concerned with joint compound or the anchoring of ribs in a wet compound. Rather, he relies on staples for mounting his extensions and covers the exterior of his joint width plastic 21 (Fig. 8).

Claim 15 specifically calls for "flaps formed with a plurality of elongated grooves and ridges with at least the inward surface including the ridges, for anchoring into joint compound on the drywall corner, and at least the outer surface including the grooves." The Examiner has failed to point to any showing in the prior art or suggestion that a drywall trim device should include a paper cover with flaps having the ridges on the interior surface and grooves on the exterior surface such that the interior surface may be anchored to joint compound. The use of plastic 21 on the exterior surface of the Compton extension teaches away from ridges formed in paper to embed and anchor on the underside to drywall joint compound. The Examiner fails to show any

characteristics of the Compton plastic insulation which would have suggested such a combination to an artisan at the time of the invention.

Claim 16 calls for the flaps to be formed be on both their outwardly facing and inwardly facing surfaces with alternating elongated grooves and ridges and being further formed with perforations disposed in the grooves. The Examiner argues that Compton shows flaps having elongated grooves and ridges on the both the inside and outside surfaces for anchoring a joint compound 21. It would appear the Examiner may have misinterpreted Compton as there is no showing that Compton does in fact include such grooves and ridges or a joint compound. The layer 21 shown on the exterior of the extension in Compton is described as being "plastic insulation covering 21" (Col. 2, ll. 26-27). There is no showing that the plastic covering would work if placed on the interior surface of the extension or any description that the extensions are mated with the plastic in a pliable state for embedding of any ridges even if they did exist. Consequently, the Examiner has failed to carry the burden of showing prima facie obviousness.

Claim 35 calls for the cover to be constructed of fibers and strengthening compound mixed together at the time of manufacture. As noted below at page 15 in conjunction with claim 47 this affords a stronger and more durable combination in the end product, a product which differs from other corner beads wherein the strengthening compound might be added post manufacture and not gain the level of encapsulation or filling of the interstices.

Claim 41 recites a tape on drywall fitting device including an elongated paper cover projecting from at least one edge to form a flap formed on the inwardly facing surface with a plurality of spaced apart ridges. As noted during the foregoing interview, there is no suggestion of modifying Kunz by adding the metal extensions 21 of Compton or of forming those extensions with ridges and grooves. In fact, to form ridges and grooves in Compton would be to create greater thickness in the spacing between the

plastic sheet 21 and blocks 15 (Fig. 8) where the extensions 20 are sandwiched. Then, if paper were substituted for the extensions and formed with ridges those ridges would be depressed and deformed by pressing the plastic covering 21 into place thus defeating the purpose of incorporating the ridges in the first place. Thus, it is clear from this record Applicant was the first to configure drywall trim with paper flaps having ridges to embed in joint compound for the purpose of securing the trim in place.

The Examiner seeks to rely on Weldy as showing corrugated surfaces with grooves and ridges and perforations to enhance attachment of jointing compound. However, Weldy teaches away from a two piece corner bead construction with paper flaps. He purposes a one-piece plastic strip formed with an integral core and reduced thickness flanges 14. He discloses and claims a strip formed from a single piece of plastic secured to a drywall panel by "nails 16 hammered directly through the flanges 14 and through the drywall 18" (Col. 3, ll. 22-23; Fig. 2). Rather than seeking to form ridges the size of Applicant's to facilitate anchoring, Weldy merely states that his flanges may be "striated as shown at 24 on their surface which will face outwardly" much like record grooves to form a roughened area for holding the mud in place on the exterior (Col. 3, ll. 34-37). The Examiner fails to reveal what he believes is the teaching of the size and configurations of the striation or to state how he believes the prior art suggests reconfiguring to provide Applicant's on the interior without defeating the objectives of Weldy.

Claims 42 – 45 all depend from claim 41 and are likewise believed allowable.

Claim 46 recites the method of making a drywall joint protection strip device by selecting an elongated core, a paper cover bonding the cover to the core to form a flexible flap and forming alternating grooves and ridges on the inwardly facing surface of the flap to confront a surface along the marginal edge of a drywall panel to be embedded in joint compound disposed between the panel and the marginal edge surface. The Examiner has rejected this claim as being obvious in view of Ritchie, Compton and Weldy. The

Examiner fails to point out where Ritchie provides for the steps of covering the core with a paper to forming alternating grooves and ridges on the inwardly facing surface of the flaps. Ritchie discloses in Figs. 1 – 4 a nail on corner bead and shows in Figs. 5 and 6 tape on corner beads with paper layers 12', 13' having respective protective bands 16 and 17 about the corner areas. Ritchie shows planar flaps without concern for enhancing the anchoring capability thereof.

Ritchie merely adopts the traditional method of fabricating his flaps in a planar form. Nowhere within the four corners of Ritchie, is it suggested that the flaps be bodily deformed in any manner. As noted above, Compton fails to teach any method of forming a drywall trim device and specifically does not teach how to make such a device by deforming a paper flap to form an alternating grooves and ridges to be embedded in joint compound. Rather, Compton relies on a mesh construction with staples for anchoring thereof. There is no suggestion in the record of converting the Compton extensions to paper, deforming those extensions and that such deformation could form ridges adequate to embed in joint compound to a sufficient degree to afford the anchoring function. Weldy is deficient in this regard. There is no showing that the striations of Weldy could be formed in one or both sides of a paper flap or any suggestion of the extent or degree to which such striations should be modified to form ridges and the deformation of the through thickness of a paper flap to define ridges adequate to anchor. Thus, as above, the only suggestion of Applicant's construction is derived from his disclosure. Such hind sight has been universally condemned.

This approach has been universally condemned by the courts. *See, e.g., Diamond Rubber Co. of New York v. Consolidated Rubber Tire Co.*, 220 U.S. 428, 31 S. Ct. 444 (1911); *In re Kamm and Young*, 172 U.S.P.Q. 298 (C.C.P.A. 1972); *Ex parte Lang*, 72 U.S.P.Q. 90, 91 (C.C.P.A. 1947) (“It seems to us that the Examiner is using appellant’s disclosure for the suggestion of the combination since there is no suggestion in any of the patents for their combination in the manner claimed by applicant.”); *In re Leonor*, 158 U.S.P.Q. 20, 21 (C.C.P.A. 1968) (the court reasoning that the issue is “whether teachings

of prior art would, of themselves, and without benefit of applicant's disclosure, suggest [a process] which would make the claimed invention obvious . . ." (emphasis court's)); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929 (Fed. Cir. 1984); and *W.L. Gore Assocs., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

Claim 47 depends from claim 46 and includes the step in making the paper from fiber elements mixed with a strengthening compound at the time of manufacture. This provides an end result where the fibers are encapsulated by the strengthening compound and interstices in the matrix of fibers is filled with the compound thus rendering the end product more durable for enhancing the strength required for anchoring and in minimizing differentials in expansion between the paper and core as a result of dehydration thus enhancing the performance of the end product.

Claim 48 provides the method of forming the outwardly facing surface of the strip with elongated grooves and configuring through perforations in the grooves for receipt of joint compound. Neither Compton nor Weldy teach a method for making a joint protection strip device with a paper extending from a core and forming the paper flaps with alternating grooves and ridges so there would be no suggestion of forming perforations in any of the grooves where the compound might be funneled into such perforations. Consequently, the only suggestion of these steps comes from Applicant's disclosure.

Claims 52, 53 and 55 stand rejected as being obvious in view of Kunz and Compton. Claim 52 recites a corner protection strip with a relatively rigid core, a relatively flexible strip projecting therefrom to form flaps and the inner sides of the flaps being formed with a plurality of alternating longitudinal flaps and grooves to be embedded in joint compound on the surfaces of drywall panels to fill the grooves and anchor the flaps in the compound.

As noted above, Kunz relies on planar flaps and Compton discloses metal mesh or perforated extensions without any disclosure of the grooves and ridges on the interior side of a flap and particularly not on the interior side of a paper flap. Consequently, as set forth above, the only suggestion for that construction is by hind sight.

Claim 53 depends from claim 52 and calls for perforations in the flaps.

Claim 54 calls for the grooves configured to funnel the compound into the perforations. This construction is not shown or suggested in the prior art.

Claim 55 depends from claim 52 and includes further limitations.

The prosecution in this case has been long and arduous. The Examiner has previously indicated that there is patentable subject matter in the case but elected to withdraw the indication of allowability relying heavily on the planar metallic mesh in the expansion joint taught by Compton for sandwiching extensions between insulation block and plastic to seal against loss of heat. This work is far different from Applicant's area of endeavor and is not typically a place where an artisan would look in seeking a solution to anchoring drywall beads into wet joint compound. The insulation expansion joint construction of Compton fails to show ridges and grooves in wings and fails to show or suggest the use of paper. Kunz teaches against the use of metal or mesh in his planar wings and impliedly admits Applicant's solution did not occur to him until after Applicant's product hit the market.


Applicant has made an important contribution to the art in making a drywall trim which has gained acceptance in the marketplace which is preferred over any of the prior art cited by the Examiner.



As pointed out at the foregoing interview it is believed that the claims in the case are now in condition for allowance and early notice thereof is respectfully solicited.

Respectfully submitted,

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